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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,538	11/12/2003	Arthur D. Johns	6678P001	9181

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EXAMINER
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DOAN, ROBYN KIEU

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/712,538

Applicant(s)

JOHNS, ARTHUR D.

Examiner

Robyn Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 19-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date <u>04/06/2004</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to a hairpiece and a method of making a hairpiece, classified in class 132, subclass 56
- II. Claims 1-13 and 19-23, drawn to a hairpiece and a method of using the device, classified in class 132, subclass 201.

The inventions are distinct, each from the other because:

Inventions I and II are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(i)).

During a telephone conversation with Mr. Babbitt on November 2, 2005 a provisional election was made without traverse to prosecute the invention of II, claims 1-13 and 19-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-18 being withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

The disclosure is objected to because of the following informalities: in paragraph 6, line 4, "200" should be changed to --120--, also in paragraph 35, line 8, "176" should be changed to --174--.

Appropriate correction is required.

### ***Drawings***

The drawings are objected to because "230" and "220" in figure 9 should be changed to --430, 420--. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

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examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clearly understood what will be a “desired volume”, a “desired length” and a “desired direction” as recited in claims 8, 9 and 13 and for the examination purpose, they are treated as including all volumes, lengths and directions.

Claim 10 is indefinite because it is unclear the “opposing side edges” belong to the foundation or the cloth material. For examination purpose, it will be treated as opposing side edges of the cloth.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-20, 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (U.S. Pat. # 4,386,619).

With regard to claim 19, Williams discloses a method of using a hair-enhancing cap (fig. 3) comprising steps of coupling a device (10) to an individual wearer's hair (col. 2, lines 3-5) using an attachment device (64), applying outside pressure to a foundation (12) of the device to cause the foundation to conform to the contours of an individual wearer's head (col. 3, lines 54-58), drawing the individual wearer's hair through geometric regions (13, fig. 1) of the device to blend the individual wearer's hair with hair sewn to the device (col. 3, lines 59-65). In regard to claim 20, Williams shows the device being coupled (fig. 3) at a crown portion (40) of an individual wearer's head. In regard to claim 22, Williams shows a first portion (at 20, fig. 3) of the device attaches to a crown portion of the individual wearer's head between an occipital bone and a top of a parietal portion of the wearer's head. In regard to claim 19, Williams shows a second portion of the device (42) enclosing a nape portion of the individual wearer's head (see fig. 3) between an occipital bone and a base of the individual wearer's scalp.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-5, 8-9 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Ball (U.S. Publication # 2004/0237985).

With regard to claim 1, Ball discloses a hairpiece (figs. 2-5) comprising a foundation (16) having a generally peripheral member (17) which is inherently capable to be worn on a rear portion of a human head, a longitudinal member (34) coupled to the peripheral member at a first point (at 14, fig. 3) and a second point (at 36, fig. 2) that bisects the peripheral member and defining a first portion (at 15, fig. 2) and a second portion (at 14) of the peripheral member, a plurality of diagonal members (21-25) each coupled to the longitudinal member and the peripheral member to divide the first and second portions into geometric regions (fig. 2) for allowing natural hair (13) of the wearer to be drawn through the geometric regions (25, 37, fig. 4, paragraph 39, lines 3-9); the foundation further including a plurality of wefts of hair (30) coupled to the plurality of diagonal members (21-25). In regard to claims 4-5, Ball shows the first portion of the peripheral member is adapted to be positioned onto a crown portion of an individual wearer's head (see fig. 3) between an occipital bone and a top of a parietal portion of the wearer's head, a second portion enclosing a nape portion of the individual wearer's head (see fig. 3) between an occipital bone and a base of the individual wearer's scalp. In regard to claim 8, Ball shows a number of geometric region (25, 37, see figure 2) being within the first portion. In regard to claim 9, Ball shows a number of geometric regions (25, 37, see figure 2) being within the second portion. In regard to claim 13, a plurality of wefts of hair (30) being attached in a desired direction according to a style desired by an individual wearer (fig. 5).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-5, 8-9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Tucciarone et al (U.S. Pat. # 3,659,621).

With regard to claim 1, Williams discloses a hair-enhancing cap (fig. 1) comprising a foundation (11) having a generally peripheral member (12) which is inherently capable of being worn on a rear portion of a human head, a longitudinal member (14) coupled to the peripheral member at a first point (16, fig. 1) and a second point (18) that bisects the peripheral member and defining a first portion (40) and a second portion (42) of the peripheral member, a plurality of diagonal members (20, 26) each coupled to the longitudinal member and the peripheral member to divide the first and second portions into geometric regions (13) for allowing natural hair (4) of the wearer to be drawn through the geometric regions; the foundation further including a plurality of hairs (62) coupled to the plurality of diagonal members. Williams does not disclose a plurality of wefts of hair, however, Tucciarone discloses a hairpiece (fig. 2) comprising a peripheral member (14) having a longitudinal member (20) and a plurality of diagonal members (28) with a plurality of wefts of hair (12) attached thereto. It would



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have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the wefts of hair as taught by Tucciarone into the device of Williams for the purpose of preventing detection of the hairpiece at the part line.

In regard to claim 2, Williams shows the peripheral member comprising a wire (col. 3, lines 44-47). In regard to claims 4-5, Williams shows the first portion (40) of the peripheral member is adapted to be positioned onto a crown portion of an individual wearer's head (see fig. 3) between an occipital bone and a top of a parietal portion of the wearer's head, a second portion (42) enclosing a nape portion of the individual wearer's head (see fig. 3) between an occipital bone and a base of the individual wearer's scalp. In regard to claim 8, Williams shows a number of geometric region (13, see figure 3) being within the first portion. In regard to claim 9, Williams shows a number of geometric regions (13, see figure 3) being within the second portion. In regard to claim 13, Williams shows a plurality of hair being attached in a desired direction according to a style desired by an individual wearer (figs. 3-4). Williams does not disclose a plurality of wefts of hair, however, Tucciarone discloses a hairpiece (fig. 2) comprising a peripheral member (14) having a longitudinal member (20) and a plurality of diagonal members (28) with a plurality of wefts of hair (12) attached thereto. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the wefts of hair as taught by Tucciarone into the device of Williams for the purpose of preventing detection of the hairpiece at the part line. It is noted that the recitation "is determined based on a desired length of the individual wearer's hair" in claim 9 and the recitation "the wefts of hair are attached in a desired

direction according to a style desired by an individual wearer" in claim 13 appear to be directed to a method of using and not to the actual structure of the device. Thus, it has been given a little weight.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Tucciarone as applied to claim 1 above, and further in view of Elliott (U.S. Pat. # 6,016,814).

With regard to claim 3, Williams in view of Tucciarone disclose a hair enhancing cap comprising all the claimed limitations in claim 1 as discussed above except for a clip coupled to a portion to the peripheral member adapted to engage a portion of natural hair of the wearer. Elliott discloses a hair device (figs. 6-7) comprising a hairpiece (100) and a clip (50) wherein the clip coupled to a portion of the hairpiece and a portion of a natural hair of a wearer (col. 3, lines 15-20). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to replace the elastic fastener (64) of Williams with the clip as taught by Elliott for the purpose of securing the hairpiece to the natural hair of the wearer.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Tucciarone.

With regard to claims 6-7, Williams in view of Tucciarone disclose a hair enhancing cap comprising all the claimed limitations in claim 1 as discussed above

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except for the geometric regions of the first portion and the second portion comprising triangular shapes or spherical triangular shapes. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the geometric regions of the first portion and the second portion comprising triangular shapes or spherical triangular shapes, since such a modification would have involved a mere change in the shape of the component. A change in shape is generally recognized as being within the level or ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams.

With regard to claim 21, Williams discloses a method of using the hair enhancing cap comprising all the claimed limitations in claim 19 as discussed above except for the geometric regions comprising triangular shapes. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the geometric regions having triangular shapes, since such a modification would have involved a mere change in the shape of the component. A change in shape is generally recognized as being within the level or ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Tucciarone as applied to claim 1 above, and further in view of Yonezo Ito (U.S. Pat. # 3,435,832).

With regard to claims 10-12, Williams in view of Tucciarone disclose a hair enhancing cap comprising all the claimed limitations in claim 1 as discussed above except for the wire of the foundation being surrounded by a cloth material which has two opposing side edges, Williams in view of Tucciarone also does not disclose the plurality of wefts of hair being coupled to the cloth material such that a weft portion of the plurality of wefts contacts a first side of the cloth material and a different side of the cloth material. Yonezo Ito discloses a wig framework (fig. 1) comprising a frame (1) being surrounded by a cloth material (5) with two opposing side edges, a plurality of hairs being coupled to the cloth (col. 2, lines 29-31) such that the hair contact one side of the cloth material. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the cloth material as taught by Yonezo Ito into the foundation of Williams in view of Tucciarone for the purpose of providing a comfortable feeling to the wearer. It would also have been an obvious matter of design choice to a person of ordinary skill in the art to place the hair wefts contacting a first side of the cloth material and a different side of the cloth material because Applicant has not disclosed that placing the hair wefts contacting a first side of the cloth material and a different side of the cloth material provides an advantage, is used for a particular purpose, or solves a stated problem. Therefore, it would have been prima facie obvious to modify Yonezo Ito to obtain the invention as specified in claim 12 because such a

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modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Yoneza Ito.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Russo, Kato and Goldman are cited to show the state of the art with respect to a wig.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robyn Doan  
Examiner  
Art Unit 3732